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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/532,787

05/23/2006

Jonathan Michael Blackburn

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35437

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04/02/2008

MINTZ LEVIN COHN FERRIS GLOVSKY & POPEO

ATTN: PATENT INTAKE CUSTOMER NO. 35437

ONE FINANCIAL CENTER

BOSTON, MA 02111

EXAMINER

GITOMER, RALPH J

ART UNIT

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1657

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/532,787	<b>Applicant(s)</b> BLACKBURN ET AL.	
	<b>Examiner</b> Ralph Gitomer	<b>Art Unit</b> 1657	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 37-60 is/are pending in the application.
- 4a) Of the above claim(s) 60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

Applicant's election without traverse of Group I, claims 37-59, in the reply filed on 1/30/08 is acknowledged. Please update the continuing information in the preamble of the specification.

Although not claimed, it appears the point of novelty of the invention as described in the specification resides in the polyethylene glycol coating to repel protein on the probe surface. See paragraph 58 in the present specification. Further, some of the dependent claims are directed to a specific buffer as discussed in paragraph 28 of the present specification. All the rest of the claimed features are well known in Maldi technology and are not considered here further.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 37-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Wagner in view of Kolster.

Wagner (WO 00/04382) entitled "Arrays of Proteins and Methods of Use Thereof" teaches on page 12, on the probe there is an organic thinfilm of polyethylene glycol which reduces the non-specific binding of molecules to the surface. Exposed functionalities serve to tether the thinfilm to the surface of the substrate or the coating. Other functions of the coating are discussed. On page 32 last paragraph affinity tags with a given functionality on the organic thinfilm are discussed.

The invention differs from Wagner in that the buffer selected is ammonium carbonate.

Kolster (6,258,538) entitled "DNA Diagnostics Based on Mass Spectrometry" teaches conventional Maldi in a number of standard applications. In column 19 line 52 ammonium carbonate buffer is shown on a mass spec platform.

It would have been obvious to one of ordinary skill in this art at the time of the invention to perform standard Maldi analysis as shown by each of the above references with a volatile buffer such as ammonium carbonate as shown by Kolster because no buffer residue would be left on the probe when dried. Employing a known buffer for its known function with the expected results would have been obvious.

Claims 37-59 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for ammonium bicarbonate buffer and polyethylene glycol bound with a poly amino acid, does not reasonably provide enablement for a semi-volatile buffer or a layer resistant to non-specific protein binding. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

In claim the terms "a semi-volatile buffer or a layer resistant to non-specific protein binding" lack enablement as it would require one of ordinary skill in this art undue experimentation to determine which such buffer or layer would work in the instant invention.

Referring the published application 2006/0275855, in paragraph 28 a semi - volatile buffer is discussed and a single example of ammonium bicarbonate is provided. In paragraph 58 a polyethylene glycol layer is shown.

The entire scope of the claims has not been enabled because:

1. Quantity of experimentation necessary would be undue because of the large proportion of inoperative compounds claimed.
2. Amount of direction or guidance presented is insufficient to predict which substances encompassed by the claims would work.
3. Presence of working examples are only for single specific substances and extension to other compounds has not been specifically taught or suggested.

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4. The nature of the invention is complex and unpredictable.
5. State of the prior art indicates that most related substances are not effective for the claimed functions.
6. Level of predictability of the art is very unpredictable.
7. Breadth of the claims encompasses an innumerable number of compounds.
8. The level of one of ordinary skill in this art is variable.

In re Wands, 858 F.2d 731, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 37-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Each of the following applies in all occurrences.

There are a number of instances of lack of antecedent basis in the claims, see claim 37 line 1, “the activity”, “the effect”. In claim 37 “characterized in that” may be intended to be “wherein”. In claim 37 “a layer resistant to non-specific protein binding is provided on the probe surface” is so indefinite that it is given no patentable weight. The layer could be the substrate of the probe, no proximity to anything is claimed and no amount resistance is claimed. And such a layer reads on any of the reactants or water. In claim 38 “such as” is improper. In claim 55 “the semi-volatile buffer” lacks definite antecedent basis. In claim 56 “typically via a tag” is indefinite as to what may be intended or if anything is claimed. In claim 57 line 2 “its” does not specify which. In

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claim 58 "preferably" renders the claim indefinite as to what may be intended. In claim 42 and all occurrences, "di" and "tri" are not words.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Koopman (2005/0196791) may be a related application.

Koopman (2003/0173513) may be a related application.

Koopman (7,057,165), which may be a related patent, claims in claim 22, polyethylene glycol on the surface, and in claim 46 a probe with a layer of protein repellent.

Nelson (Mass Spec Rev) teaches standard Maldi technique on page 356 Fig. 1 and page 357 "C. Evaluation". See also page 371 "D. Activity".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ralph Gitomer whose telephone number is (571) 272-0916. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on (571) 272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ralph Gitomer/  
Primary Examiner, Art Unit 1657

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Primary Examiner  
Art Unit 1657